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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,958	09/15/2003	Shannon Walker Williams	035706-0106	1040

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EXAMINER

KIM, CHRISTOPHER S

ART UNIT PAPER NUMBER

3752

DATE MAILED: 05/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/662,958

Applicant(s)

WILLIAMS ET AL

Examiner

Christopher S. Kim

Art Unit

3752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 and 28-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of Species A, figure 5 in the reply filed on March 14, 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claim 27 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on March 14, 2005.

### ***Response to Amendment***

3. The response filed on December 3, 2004 is acknowledged.
4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:  
  
The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
6. Claim 33 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which

was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The application as originally filed does not appear to disclose "the depressment surface not extending radially outwardly beyond the housing" recited in claim 33.

***Claim Rejections - 35 USC § 102***

7. Claims 1-6, 10, 11, 14, 15, 17-20, 31, 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Gebauer (2,171,501).

Gebauer discloses an applicator comprising: a propellant container 10; a nozzle 32; an actuator 29; a trigger 28; a housing 13, 35.

The recitation "nail polish" has been considered a descriptive phrase defining the intended use of the device and has been given no patentable weight. The device of Gebauer is not prohibited from being used as a nail polish applicator.

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 UPQ2d 1647(1987).

Even if patentable weight was given to the intended use of the apparatus, to dispense nail polish, Gebauer discloses dispensing ethyl chloride, either alone or admixed with one or more other liquids (see page 1, lines 1-12). Ethyl chloride is a

compound in nail polish. US Patent Number 4,646,765 to Cooper et al. is provided as evidence. Therefore, the ethyl chloride of Gebauer constitutes nail polish.

Regarding claim 11, Gebauer discloses a cap 35.

8. Claims 1-4, 6, 7, 15, 17, 19-21, 24-26, 28-30, 34, 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Beres et al. (3,305,144).

Beres discloses an applicator comprising: a container 10; a nozzle 26; an actuator 70; a housing 58, 64; an aerosol valve 14.

The nozzle 26 is in-line with the longitudinal axis of the container when oriented as such.

The recitation "nail polish" has been considered a descriptive phrase defining the intended use of the device and has been given no patentable weight. The device of Beres is not prohibited from being used as a nail polish applicator.

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 UPQ2d 1647(1987).

Regarding claim 21, the aerosol container 10 of Beres inherently has a dip tube.

9. Claims 1-6, 10, 11-14, 15, 17-20, 31, 35, 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Gebauer (2,768,032).

Gebauer discloses an applicator comprising: a propellant container 1; a nozzle 18; an actuator 23; a trigger 20; a housing 5, 12; a cap 25.

The recitation "nail polish" has been considered a descriptive phrase defining the intended use of the device and has been given no patentable weight. The device of Gebauer is not prohibited from being used as a nail polish applicator.

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 UPQ2d 1647(1987).

Even if patentable weight was given to the intended use of the apparatus, to dispense nail polish, Gebauer discloses dispensing ethyl chloride, either alone or admixed with one or more other liquids (see page 1, lines 1-12). Ethyl chloride is a compound in nail polish. US Patent Number 4,646,765 to Cooper et al. is provided as evidence. Therefore, the ethyl chloride of Gebauer constitutes nail polish.

Regarding claim 35, Gebauer discloses a housing 5, 12, 25

10. Claims 1, 3, 4, 6, 8, 10, 11, 14, 15, 19-20, 28-30, 31, 32, 35, 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Knight et al. (3,306,252).

Knight discloses an applicator comprising: a propellant container 11; a nozzle 43; an actuator 19; a housing 14; a valve 26.

The recitation "nail polish" has been considered a descriptive phrase defining the intended use of the device and has been given no patentable weight. The device of Knight is not prohibited from being used as a nail polish applicator.

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from

a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 UPQ2d 1647(1987).

Regarding claim 11, Knight discloses a cap 14

11. Claims 1-4, 6, 10, 11, 14, 15, 17-21, 23, 31, 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Gebauer (2,313,930).

Gebauer discloses an applicator comprising: a propellant container 10; a nozzle 16a; an actuator 20; a trigger 18; a housing 13, 14; a dip tube 23.

The recitation "nail polish" has been considered a descriptive phrase defining the intended use of the device and has been given no patentable weight. The device of Gebauer is not prohibited from being used as a nail polish applicator.

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 UPQ2d 1647(1987).

Regarding claim 11, Gebauer disclose a cap 14.

12. Claims 1, 3, 4, 6, 9, 15, 17-21, 28-30, 34, 36, 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Meshberg (2,914,222).

Meshberg discloses, in figure 6, an applicator comprising: a propellant container 15; a nozzle 38; an actuator 39; a housing 11.

The recitation "nail polish" has been considered a descriptive phrase defining the intended use of the device and has been given no patentable weight. The device of

Meshberg is not prohibited from being used as a nail polish applicator. Note that Meshberg discloses, in column 1, lines 45-50, dispensing cosmetics.

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 UPQ2d 1647(1987).

Regarding claim 21, the aerosol container 11 of Meshberg inherently has a dip tube.

### ***Claim Rejections - 35 USC § 103***

13. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gebauer (2,171,501).

Regarding claim 16, Gebauer discloses the limitations of the claimed invention with the exception of the diameter of the container proximate the actuator. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have limited the container outer diameter proximate the actuator to not greater than 1.0 inch, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

14. Claims 1-4, 6, 7, 15, 17, 19, 20, 21, 24, 25, 26, 28, 29, 30, 34, 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al. (3,130,734) in view of Beres et al. (3,305,144).



Ellis discloses dispensing a nail polish using a pressurized can 12.

Beres discloses an applicator comprising: a container 10; a nozzle 26; an actuator 70; a shousing 58, 64; an aerosol valve 14. The nozzle 26 is in-line with the longitudinal axis of the container when oriented as such. Regarding claim 21, the aerosol container 10 of Beres inherently has a dip tube.

It would have been obvious to a person having ordinary skill in the art at the time of the invention to have used the device of Beres to spray nail polish of Ellis for mobility and manipulation of the nozzle without moving the container (Beres, column 2, lines 15-31).

15. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Meshberg (2,914,222) in view of Fulton et al. (3,088,680).

Meshberg discloses the limitations of the claimed invention with the exception of the dip tube extending proximate to the side surface of the container. Fulton discloses a tube 14 extending proximate to the side surface of container 11. It would have been obvious to a person having ordinary skill in the art at the time of the invention to have provided the flexible dip tube of Fulton to the device of Meshberg to dispense the container in various orientations.

### ***Response to Arguments***

16. Applicant's arguments filed December 3, 2004 have been fully considered but they are not persuasive.

Applicant argues that Gebauer does not disclose a nail polish. The recitation "nail polish" has been considered a descriptive phrase defining the intended use of the device and has been given no patentable weight. The device of Gebauer is not prohibited from being used as a nail polish applicator.

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 UPQ2d 1647(1987).

Even if patentable weight was given to the intended use of the apparatus, to dispense nail polish, Gebauer discloses dispensing ethyl chloride, either alone or admixed with one or more other liquids (see page 1, lines 1-12). Ethyl chloride is a compound in nail polish. US Patent Number 4,646,765 to Cooper et al. is provided as evidence. Therefore, the ethyl chloride of Gebauer constitutes nail polish.

Claims 1 and 37 define an apparatus and a prior art apparatus does not undergo metamorphic change merely because one fills the apparatus with a different fluid that is to be dispensed.

***Conclusion***


17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher S. Kim whose telephone number is (571) 272-4905. The examiner can normally be reached on Monday - Thursday, 6:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Scherbel can be reached on (571) 272-4919. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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Art Unit 3752

CK